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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,361	09/24/2001	Masakazu Tanaka	12-007	6343

23400 7590 03/19/2003

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EXAMINER

WRIGHT, WILLIAM G

ART UNIT

PAPER NUMBER

1754

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DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/960,361	TANAKA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	William G. Wright SR.	1754	
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>			
<b>Period for Reply</b>			
<p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>			
<b>Status</b>			
<p>1)<input type="checkbox"/> Responsive to communication(s) filed on _____.</p> <p>2a)<input type="checkbox"/> This action is FINAL.                  2b)<input checked="" type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>			
<b>Disposition of Claims</b>			
<p>4)<input checked="" type="checkbox"/> Claim(s) <u>1-18</u> is/are pending in the application.</p> <p>  4a) Of the above claim(s) <u>8-11 and 16-18</u> is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6)<input checked="" type="checkbox"/> Claim(s) <u>1-7 and 12-15</u> is/are rejected.</p> <p>7)<input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8)<input checked="" type="checkbox"/> Claim(s) <u>1-18</u> are subject to restriction and/or election requirement.</p>			
<b>Application Papers</b>			
<p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input type="checkbox"/> The drawing(s) filed on _____ is/are: a)<input type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner.</p> <p>  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p>11)<input type="checkbox"/> The proposed drawing correction filed on _____ is: a)<input type="checkbox"/> approved b)<input type="checkbox"/> disapproved by the Examiner.</p> <p>  If approved, corrected drawings are required in reply to this Office action.</p> <p>12)<input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>			
<b>Priority under 35 U.S.C. §§ 119 and 120</b>			
<p>13)<input checked="" type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>  a)<input checked="" type="checkbox"/> All b)<input type="checkbox"/> Some * c)<input type="checkbox"/> None of:</p> <p>    1.<input checked="" type="checkbox"/> Certified copies of the priority documents have been received.</p> <p>    2.<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p>    3.<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p> <p>  * See the attached detailed Office action for a list of the certified copies not received.</p> <p>14)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).</p> <p>  a)<input type="checkbox"/> The translation of the foreign language provisional application has been received.</p> <p>15)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.</p>			
<b>Attachment(s)</b>			
<p>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.</p>		<p>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____.</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____</p>	

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Applicant's election without traverse of Group I, claims 1-7 and 12-15 in Paper No. 5 is acknowledged.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

~~Kept~~ Claims 1-7 and 12-15 are rejected under 35 U.S.C. § 102(b) as being anticipated by Beauseigneur et al. '570. Note the Examples and the claims of the reference.

~~Kept~~ Claims 1, 2, 12 and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Komatsu et al. '191. Note the embodiments and the claims.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a),

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the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Keep Claims 1-7 and 12-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beauseigneur et al. '570.

The reference teaches the claimed features to include the applicant's claimed particle size, microcracks, cordierite material and a porous catalyst support. The specific use of the effects is not found in the reference and is inferred from the microcracks found at column 7 et seq., as a way of producing microcracks. The reference teaches the claimed invention to be obvious.

Keep Claims 1, 2, 12 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Komatsu et al. '191.

The reference teaches the use of ultrafine particles of the size of 1 to 10 nanometers. The instant claims teach particles of the size 100 nanometers or less, the reference teaches at column 8 line 13 et seq. the quantum size effect and how the

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number of atoms and their size is related to this effect.

Depending on atomic size, there will be a change in the particle size and with this change, due to atom size, it will be seen that the particle size will change. The particle size of 100 nanometers and less is taught to ~~be~~ <sup>be</sup> obvious from these teachings. The claimed invention is obvious from the teachings of the reference.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Drafted  
OVP Claims 1-7 and 12-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-41 of copending application Serial No. 09/960,498 to Tanaka et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope of subject matter claimed.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Droped Claims 1-7 and 12-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending application Serial No. 09/961,151 to Kondo et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope of subject matter claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Keep Claims 1-7 and 12-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending application Serial No. 09/961,203 to Nakanishi et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope of subject matter claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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*OK*  
*Drafted* Claims 1-7 and 12-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-41 of copending application Serial No. 09/966,723 to Koiki et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope of subject matter claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*OK*  
*Drafted* Claims 1-7 and 12-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of copending application Serial No. 10/103,568 to Tanaka et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope of subject matter claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*OK*  
*Drafted* Claims 1-7 and 12-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending application Serial No. 10/180,033 to Tanaka et al. Although the conflicting

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claims are not identical, they are not patentably distinct from each other because they overlap in scope of subject matter claimed.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*OK  
for ref.* Claims 1-7 and 12-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending application Serial No. 10/202,826 to Tanaka et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope of subject matter claimed.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William G. Wright, Sr. whose telephone number is (703) 305-7792. The examiner can normally be reached on Monday through Thursday from 6:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on (703) 308-3837. The fax phone number for the

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organization where this application or proceeding is assigned are (703) 872-9310 for the regular communications and (703) 872-9311 for after final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1495.

WGW

W. G. Wright, Sr.:cdc

March 17, 2003

SB~  
STEVEN BOS  
PRIMARY EXAMINER  
GROUP 1100